

REMARKS

Applicants appreciate the confirmation that the prior grounds of rejection have been overcome. However, the Official Action now rejects the pending claims, that is, Claims 46-52, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,460,138 to Robert P. Morris in view of U.S. Patent No. 6,327,459 to Peter M. Redford, et al. Although Applicants do not concur with the rejections, Claims 46-52 have now been canceled and new Claims 53-65 have been added to more clearly patentably distinguish the claimed invention from the cited references, taken either individually or in combination. Based on the foregoing amendments and the following remarks, Applicants therefore respectfully request reconsideration of the present application and allowance of the claims.

The new claims include three independent claims – Claims 53, 58 and 61. Independent Claim 53 recites a hand-held portable electronic display device for viewing protected information, while independent Claim 58 recites a method for viewing protected information in a hand-held portable electronic display device. Further, independent Claim 61 recites an apparatus for covering a hand-held portable electronic display device. The hand-held portable electronic display device of independent Claim 53 includes an electronic display, a memory coupled to the display for storing the protected information in an encrypted format and for storing a first decryption code associated with the protected information. The hand-held portable electronic display device of independent Claim 53 also includes circuitry coupled to both the display and the memory for reading the first encryption code from memory. The display device of independent Claim 53 also includes a connector for attaching a removable cover to the display. The removable cover includes a tag including a second decryption code associated with the protected information. In addition to reading the first encryption code from memory, the circuitry is capable of: (i) reading the first decryption code from memory and the second decryption code from the tag if the cover is physically attached to the display, (ii) comparing the first and second decryption codes and (iii) decrypting the protected information stored in memory and displaying the decrypted protected information in an unencrypted format on the

display if the cover is physically attached to the display and if the first and second decryption codes are compatible.

Similarly, independent method Claim 58 includes the steps of receiving and storing protected information in an encrypted format and a first encryption code associated with the protected information. The method of independent Claim 58 also detects the presence of a tag affixed to a removable cover associated with the protected information and reads a second decryption code from the tag. Finally, the first and second decryption codes are compared, and the protected information that is stored in memory is decrypted and displayed in an unencrypted format on the hand-held portable electronic display device if the first and second decryption codes are compatible.

Finally, new independent Claim 61 has been added which recites an apparatus for covering a hand-held portable electronic display device that includes a cover; a connector for removably attaching said cover to the display device, and a tag containing an encryption code associated with protected information stored by the display device. The encryption code of said tag is capable of being compared to an encryption code stored by the display device such that the protected information is accessible if said cover is mounted to the display device and the respective encryption codes match.

Turning now to the cited references, the Morris '138 patent, as noted by its abstract, describes "[a] system and method for authenticating a user of a portable electronic device having a removable memory using symmetric cryptography." In this regard, the portable electronic device is capable of receiving a removable memory element, such as a flash card, which includes information with which the user may be authenticated. According to the Morris '138 patent, the removable memory element generally includes the digital signature of the user, as well as an encrypted PIN of the user. With respect to the digital signature, the user generally initially enters a message on a personal computer or other computing device. The message is then hashed to create a message digest. Both the message digest and the original message are then encrypted with the private key of the user with the combination of the encrypted message digest and message serving as the digital signature of the user. Both this digital signature and the PIN of

the user may then be encrypted with the public key of the user. This encrypted form of the digital signature and the encrypted PIN may both be stored by the removable memory element.

In order to utilize the portable electronic device, a user can insert the removable memory element. Utilizing the private key of the user that is pre-stored by the portable electronic device, the portable electronic device can decrypt the PIN and the digital signature. Once the PIN has been decrypted, the portable electronic device can prompt the user to enter a PIN, and the PIN entered by the user and the decrypted PIN are then compared. If the PINs match, the portable electronic device proceeds to decrypt the message digest and the message with the public key of the user that is also pre-stored by the portable electronic device. Following this decryption, the decrypted message is then hashed, and the result is compared to the decrypted message digest. If the hashed message matches the decrypted message digest, the digital signature is verified, and the user can then utilize the portable electronic device. Otherwise, access to the portable electronic device is denied.

Relative to the claimed invention, the Morris '138 patent does not teach or suggest a memory for storing protected information in an encrypted format, as recited by the independent claims. Applicants note that the digital signature and the PIN of the Morris '138 patent may be considered protected information, as both are encrypted and must be decrypted before being further processed. However, the digital signature and the PIN are not protected information as contemplated by independent Claims 53 and 58, since the protected information is not only stored by the memory, but also displayed by an electronic display. Not only does the Morris '138 patent not teach or suggest that the digital signature and the PIN are displayed, but such display by the Morris portable electronic device would appear counterproductive to the desired secrecy with which the digital signature and the PIN are handled.

The Morris '138 patent also fails to teach or suggest the provision and utilization of first and second decryption codes as contemplated by independent Claims 53, 58 and 61. In this regard, the new independent claims define the first decryption code to be stored by memory and the second decryption code to be included with a tag affixed to a removable cover. The first and second decryption codes are read from memory and from the tag, respectively, by circuitry and are then compared to one another, as further recited by new independent claims.

At the outset, it is noted that the Official Action appears to introduce some uncertainty in its interpretation of the decryption codes disclosed by the Morris '138 patent. In this regard, elements d and e of paragraph 6 of the Official Action appear to indicate that the private and public keys of the users are considered the first and second decryption codes, respectively. In contrast, elements f and g of paragraph 6 appear to consider the original message digest and the message digest that is newly created by hashing of the decrypted message to be the first and second decryption codes, respectively. Applicants submit, however, that under either interpretation of the Morris '138 patent, the claimed invention is patentably distinct. In this regard, under neither interpretation is the second decryption code carried by a tag affixed to a removable cover, as recited by each new independent claim. As a result, the Morris '138 patent also fails to teach or suggest circuitry for or a step of reading the second decryption code from the tag if the cover is attached, as recited by the new independent claims. Moreover, in the instance in which the private and public keys are considered the first and second decryption codes, respectively, the private and public keys are not compared to one another, as recited by the step of "comparing said first decryption code and said second decryption code" of independent Claims 53 and 58 and the recitation that "the encryption code of said tag is capable of being compared to an encryption code stored by the display device" of independent Claim 61.

Regardless of the definition of the first and second decryption codes, none of the elements considered by the Official Action to be decryption codes are compared for purposes of determining their compatibility with one another as a prerequisite for decrypting and then displaying protected information stored by memory, as recited by the new independent claims. In this regard, independent Claims 53 and 58 recite decrypting and then displaying the protected information stored in memory if the first decryption code is compatible with the second decryption code. Instead, the private and public keys of the Morris '138 patent are merely utilized to decrypt the digital signature and the PIN, neither of which is thereafter displayed in an unencrypted format on the display, while the message digests are merely compared to one another to determine if the digital signature is valid with no ensuing decryption and display of protected information.

As noted by the Official Action, the Morris '138 patent also fails to teach or suggest a removable cover attached to the display and a tag affixed to the cover and including a second decryption code, as set forth by new independent Claims 53, 58 and 61. As such, the Official Action combines the Redford '459 patent with the Morris '138 patent in formulating the obviousness rejection. Initially, Applicants submit that the requisite motivation or suggestion for combining the Redford '459 patent with the Morris '138 patent is lacking.

In this regard, in order to properly combine references, a teaching or motivation to combine the references is essential. *In re Fine*, 337 F.2d 1071, 1075 (Fed. Cir. 1988). In fact, the Court of Appeals for the Federal Circuit has stated that, "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999). Although the evidence of a suggestion, teaching, or motivation to combine the references commonly comes from the prior art references themselves, the suggestion, teaching, or motivation can come from the knowledge of one of ordinary skill in the art or the nature of the problem to be solved. *Id.* In any event, the showing must be clear and particular and "[b]road conclusory statements regarding the teaching effect of multiple references, standing alone, are not 'evidence'." *Id.*

The Official Action indicates that it would have been obvious to one of ordinary skill in the art to combine the removable cover and the tag affixed thereto as described by the Redford '459 patent to the portable electronic device of the Morris '138 patent "because this would provide the user with a level of comfort as taught by Redford, et al. (col. 20 lines 36-39)." See Official Action, page 4. Applicants initially note that the Morris '138 patent and the Redford '459 patent are drafted to dramatically different systems, with the Morris '138 patent being directed to a portable electronic device having a removable memory element for authenticating a user without requiring the user to utilize a smart card and the Redford '459 patent directed to a remote control, such as for a television or a personal computer, that includes a base and a detachable insert.

In this regard, the insert of the Redford '459 patent may be a booklet, an advertisement, a business card or the like and may be inserted into the base. The base includes buttons or other

switch-like elements such that by attaching the insert to the base and then pressing a certain portion of the insert, a respective button or other switch-like element is actuated. In turn, the base transmits a corresponding signal to the host such that a corresponding image or display is presented. The base is adapted to receive a number of different inserts. In order to determine which insert has been mounted to the base and to correspondingly permit the signal created by pressing certain portions of the insert to be properly interpreted by the host, the insert generally includes a predetermined pattern, such as a barcode. The base can have a corresponding sensor, such as a barcode scanner, for reading the predetermined pattern carried by the insert and for providing signals to the host identifying the predetermined pattern. As such, the host can determine that the particular insert that has been mounted to the base and can correspondingly interpret the signals indicative of the portions of the insert that have been pressed. The host can therefore respond differently even if the same button has been depressed if different inserts are mounted to the base.

By way of example, an optical disk may include or otherwise be associated with an insert. As such, the optical disk can be installed along with a number of other optical disks so as to be in communication with the host. The insert of a respective optical disk can then be attached to the base. The scanner of the base can read the predetermined pattern carried by the insert and can transmit a signal to the host conveying the predetermined pattern of the insert. Based upon a predetermined pattern, the host can determine the particular optical disk that corresponds with the insert. As such, the signals provided by the base to the host in response to the user depressing certain portions of the insert will cause the host to present corresponding portions drawn from the optical disk that is associated with the particular insert.

Since the Morris '138 patent is particularly directed to a portable electronic device that receives a removable memory element to authenticate a user without requiring a smart card and further since the Morris '138 patent does not teach or suggest that the portable electronic device interacts with a host as a remote control or otherwise, Applicants submit that one of ordinary skill in the art would not have been motivated to modify the portable electronic device of the Morris '138 patent in such a manner as to receive a detachable insert that is capable of being individually identified and thereafter utilized to properly interpret the signals transmitted by the

portable electronic device to a host, such as to control the display provided by the host, and, instead, submit that such a combination appears to be impermissibly guided by a hindsight analysis of the claimed invention. Not only does such a modification appear to lack the requisite motivation or suggestion, but such a modification would require an inappropriate modification in the principle of operation of the portable electronic device of the Morris '138 patent, both in terms of structure and function. As described by the MPEP, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." See MPEP § 2143.01.

For each of the foregoing reasons, Applicants submit that the Redford '459 patent may not properly be combined with the Morris '138 patent. As such, the rejection of the claims is respectfully traversed. Even if the references were combined, however, the combination of the references still fails to teach or suggest the claimed invention. In this regard, the combination of references still fails to teach or suggest that the hand-held portable electronic display device includes memory for storing protected information in an encrypted format, as recited by independent Claims 53 and 58.

While the only information that is described by the Morris '138 patent to be stored in an encrypted format is the digital signature and the PIN, neither of which are displayed, the remote control of the Redford '459 patent does not store any protected information and, instead, the Redford system contemplates that the host will store the protected information. Applicants note that the remote control of the Redford '459 patent does include memory that stores an identity code that may identify the base to the host. However, the identity code is not described to be stored in an encrypted format and, in any event, is not displayed following decryption, as recited by the independent claims. Instead, the identity code merely serves to identify the base. Moreover, the protected information stored by the host of the Redford '459 patent is not stored in an encrypted format, as recited by independent Claims 53 and 58.

Since the combination of references does not teach or suggest storing protected information in an encrypted format, the combination of references likewise fails to teach or

suggest decrypting the protected information and displaying the decrypted protected information in an unencrypted format on the display, as also recited by independent Claims 53 and 58.

Additionally, the cited references, taken either individually or in combination, also fail to teach or suggest new independent Claim 61 which recites an apparatus for covering a hand-held portable electronic display device that includes a cover; a connector for removably attaching said cover to the display device, and a tag containing an encryption code associated with protected information stored by the display device. In this regard, the insert of the Redford '459 patent does not include a connector for removably attaching the insert to the base, while neither references teaches or suggest that the encryption code of said tag be capable of being compared to an encryption code stored by the display device such that the protected information is accessible if said cover is mounted to the display device and the respective encryption codes match, as further recited by new independent Claim 61.

For each of the foregoing reasons, new independent Claims 53, 58 and 61 are not taught or suggested by the Morris '138 patent and the Redford '459 patent, even if those references were to be combined. Since dependent Claims 54-57, 59, 60 and 62-65 include, by dependency, at least the same recitations as a respective one of the new independent claims, the combination of references also fails to teach or suggest these dependent claims for at least the same reasons as described above in conjunction with the independent claims. However, several of the dependent claims include additional recitations that are also not taught or suggested by the combination of references and that provide additional bases for patentability.

In this regard, dependent Claims 54 and 59 recite the step of, and circuitry for, clearing the protected information from the display if the cover is removed from the display. The Morris '138 patent does not disclose a cover as noted by the Official Action and although the Redford '459 patent does describe removing the insert from the base, the Redford '459 patent does not teach or suggest clearing the protected information from the display. The Official Action contends that prior claims that were similar to dependent Claims 54 and 59 are obviated by the alleged locking of the portable electronic device of the Morris '138 patent following removal of the removable memory. Even if the portable electronic device of the Morris '138 patent were to be locked following removal of the removable memory, this locking does not necessarily

correlate to the clearing of a display which may continue to display the most recently displayed information even though further operation may be prevented.

As to dependent Claims 55 and 60, the hand-held portable electronic display device is described to include a receiver for wirelessly receiving into memory the protected information in an encrypted format along with the first decryption code. As such, the hand-held portable electronic display device and associated method of dependent Claims 55 and 60 are capable of wirelessly downloading protected information in an encrypted format along with the corresponding decryption code. The Official Action contends that the external generation of authentication information, i.e., digital signature, obviates the wireless receipt of protected information and the first decryption code. First, Applicants note that the Morris '138 patent does not teach or suggest that the authentication information is wirelessly transmitted to the removable memory device. Secondly, the authentication information does not constitute protected information as set forth by dependent Claims 55 and 60, for the reasons described above.

Similarly, the Official Action contends that the transmission over a network to the portable electronic device of the Morris '138 patent obviates the wireless reading of the second decryption code from the tag. Dependent Claims 56 and 63 have now been added, however, to recite that the second decryption code is obtained through one of an inductive connection and a capacitive connection. However, the Morris '138 patent does not teach or suggest a cover having a tag and, in any event, does not teach or suggest the reading of a decryption code from the tag via an inductive or capacitive connection. Likewise, the Morris '138 patent does not teach or suggest a cover having a tag that comprises a web server as now recited by new dependent Claim 64.

As described above, the Morris '138 patent and the Redford '459 patent, taken either individually or in combination, do not teach or suggest the apparatus for covering a hand-held portable electronic display device, the hand-held portable electronic display device itself and an associated method of the claimed invention. As such, Applicants submit that the prior rejections are no longer applicable relative to new Claims 53-65.

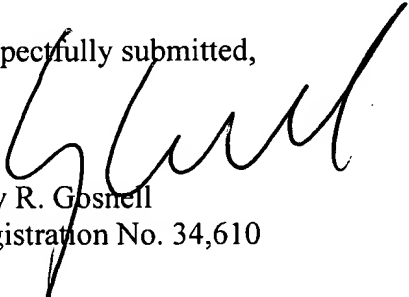
Appl. No.: 09/441/271
Amdt. dated August 18, 2005
Reply to Office action of February 18, 2005

CONCLUSION

In view of the new set of claims and the remarks presented above, it is respectfully submitted that all of the claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 50-0270.

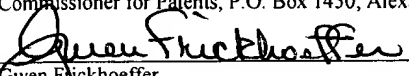
Respectfully submitted,


Guy R. Gosnell
Registration No. 34,610

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111
CLT01/4734900v1

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE,
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 18, 2005


Gwen Fickhoeffter